

REMARKS

Status of the Application

Claims 1-4 are the claims that have been examined in the pending application. Claims 1-3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kohtani et al. (U.S. Patent No. 5,475,475) in view of Rourke (U.S. Patent no. 5,191,429). Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kohtani et al. (U.S. Patent No. 5,475,475) in view of Rourke (U.S. Patent No. 5,191,429) and further in view of Petchenkine et al. (U.S. Patent No. 6,624,908).

Preliminary Matters

Applicant thanks the Examiner for acknowledging acceptance of the drawings filed on December 21, 2001.

Claim Rejections under 35 U.S.C. § 103(a)

A. *Claims 1-3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kohtani et al. (U.S. Patent No. 5,475,475) in view of Rourke (U.S. Patent no. 5,191,429).*

Claim 1 recites, in part, “wherein said data editing section edits the same number of image data, in the event that there is an image of which size extends over a one area when a sheet of paper is divided into said same number of areas in said same number of images represented by said same number of image data, in such a manner that a portion projected from said one area of the image of which size extends over said one area is removed and a remaining portion is recorded on said one area of the image of which size extends over said one area.” The Examiner argues in the Response to Arguments, on page 2 of the Office Action, that “[i]t is old and well known in the art that cropping an images gives the option to removal unwanted areas of a

scanned image ... giving the user the ability to edit the image to a size and shape the user deems necessary.” Office Action page 2. For support, the Examiner cites to Col. 6, lines 41-42 of Rourke. Applicant respectfully disagrees with the Examiner’s characterization of the teaching in Rourke.

Col. 6, lines 41-42 discloses that a scanned image is cropped after scanning to remove the extraneous image areas. However, in Rourke, the extraneous image areas are the darkened areas which do not contain the scanned image. Rourke discloses the cropping of these darkened areas before the image is reproduced as multiple copies of the image on a single sheet of paper. The cropping allows the user to identify the correct size of the image to be copied and allow a program to set the correct number of copies based on the size of the image. See col. 6, lines 43-63.

Claim 1, on the other hand, recites that a portion of an image whose *size extends over* a one area is removed, and the *remaining* portion is recorded. Because Rourke does not teach or suggest that a portion of a portion of *an image* is removed, Rourke fails to cure the defects noted by the Examiner in Kohtani with regard to claim 1.

Further, in response to Applicant’s argument that there is no motivation to combine Rourke and Kohtani, the Examiner argues that the present invention does in fact remove extraneous and unwanted parts of the scanned image, citing the Specification, page 11, line 24-page 12, line 1. Applicant respectfully disagrees with the Examiner’s characterization of the current specification. Page 11, line 24-page 12, line 1 recites, in part, “image data is edited in such a manner that the projected portion of the image is removed and the remaining portion is recorded.” The specification does not say that the projected portion is unwanted or extraneous.

The projected portion is simply larger than the area on which it is being recorded, and the projected portion is accordingly removed.

Additionally, the Examiner asserts that Rourke discloses “the removal of portions of the scanned image that project beyond what the user deems necessary ... by using the margins to set what is to be the final display”, citing Col. 6, lines 56-63. The cited section of Rourke teaches that a user may set the final margins of a page of the multiple copies of the single scanned image on the page; it does not teach the setting of the final margins of the scanned image. See col. 6, lines 56-63.

Based on the above, claim 1 is patentable over the applied art. Claim 3 is patentable at least by virtue of its dependency from claim 1.

With further regard to claim 3, this claim describes that a size of an object is maintained after the projected area is removed. However, Kohtani clearly teaches automatic reduction/magnification rather than size maintenance and this essentially teaches away from claim 3. Similarly, Rourke comprises rescaling of images. Col. 6, last line to col. 7, line 2.

Claim 2 recites similar limitations to claim 1. Therefore, for reasons analogous to those presented with regard to claim 1, claim 2 is patentable over the applied art.

B. Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kohtani et al. (U.S. Patent No. 5,475,475) in view of Rourke (U.S. Patent No. 5,191,429) and further in view of Petchenkine et al. (U.S. Patent No. 6,624,908).

Claim 4 is dependent from claim 1. Therefore, because the combination of Kohtani and Rourke fails to teach or suggest all of the limitations of claim 1, and because Petchenkine fails to

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cure the defects noted in Kohtani and Rourke with regard to claim 1, claim 4 is patentable at least by virtue of its dependency.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


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